REMARKS

This is intended to be a complete response to the Office Action mailed November 17, 2009. In the Office Action, claims 1 and 20-31 were rejected and claims 4 and 32 were objected to. To begin with, Applicant wishes to thank Examiner Pich for his review of the pending claims in view of the cited references. However, for at least the reasons set forth below, Applicant submits that the pending claims are now in condition for allowance and therefore respectfully requests reconsideration and withdrawal of each objection and rejection of the pending claims as passage of said claims to allowance.

Applicant wishes to note that the currently amended claims include amendments and/or cancellations previously e-mailed to Examiner Shan, but which, according to PAIR, were not entered into the instant application and therefore not considered by Examiner Pich.

In the response, independent claims 1 and 20 are amended as suggested by Examiner Pich and also to more clearly define the inventive concepts recited in the instant application. Support for the amendments can be found, for example, in paragraphs [0040]-[0043] of the disclosure. Dependent claims 21-22, 14-27 and 29 are also amended, as suggested by Examiner Pich. Claims 2-3, 5-19, 23, 28 and 31-32 are currently cancelled from consideration in the instant case. Therefore, rejections and/or objections to these cancelled claims are rendered moot.

Lastly, new dependent claim 33 is submitted which is directed to a particular inventive feature of the presently claimed invention. Support for new claim 33 can also

be found, for example, in paragraphs [0040]-[0043]. Therefore, new claim 33 does not introduce new matter.

Claim Objections

The Office Action objects to claims 1, 4, and 20-32 because of a variety of informalities. The Office Action further directs Applicant to review the remaining claims to find any other informalities which may render the claims indefinite. Submitted are amendments to the pending claims which Applicant believes corrects the informalities discussed in the Office Action as well as other informalities identified by Applicant. In view of the amendments, Applicant believes that the claims are definite and now particularly point out the inventive subject matter contained in Applicant's disclosure. Therefore, Applicant respectfully requests reconsideration and withdrawal of each objection to the pending claims.

Rejection of Claims 1, 20-21, 23 and 30-31 – 35 U.S.C. § 103

The Office Action rejects claims 1, 20-21, 23 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over Martinez (U.S. Pat. No. 7,136,490) in view of Grant McDonald ("Meet Critter: serial 2000, An interview with Critter of Serial 2000"). Applicant notes that independent claim 31 is cancelled from consideration in the instant application. Therefore, the rejection of claim 31 is rendered moot.

With regards to the remaining rejected claims, Applicant submits that the asserted combination of Martinez and McDonald does not teach or suggest the

inventive subject matter recited in Applicant's amended independent claims 1 and 20. In particular, Applicant submits that the combination does not teach or suggest a method for distributing a password-protected content file "wherein the password embedded within the unlocking program is not revealed to a recipient using the recipient's computer," as recited in amended claim 1, or a system "wherein the password locking the password protected content file is not revealed to a recipient viewing the password protected content file," as recited in amended claim 20. In fact, the Martinez and McDonald references teach away from such inventive features by requiring that the user know the relevant password.

As background, Applicant's inventive concepts are directed to a method and system for distributing password-protected content files from a file owner to a recipient or user of the content file without the recipient knowing the password that protects the content file, i.e., without revealing the password to the recipient. In describing prior methods of distributing password protected content files, the instant application recites:

> [0002] In certain instances, such [distributed password-protected] content files are protected by more than one password. For example, .pdf files commonly have two passwords: a user password, and an owner password. If a party knows the owner password, then such party can print the content file, save the content file under another name, or in general have all rights of the content owners. For this reason, many content owners will specify a user password which upon use provides the user with much less rights with respect to such file. Common user privileges would be only to view such content file. The user would typically not have the ability to print, make copies, or to distribute such content file.
>
> [0003] There are two common manners to avoid the protection of the .pdf file. The first manner to avoid the protection accorded the .pdf file is to "capture" the screen to the computer's clipboard. Each captured screen is then saved as a separate file and then the separate files are then consolidated into a single file. The second manner is to use a password

> cracker program. For .pdf files, a product entitled "Advanced PDF Password Recovery" is available from ElComSoft Proactive Software. Elcomsoft's software requires the recipient of the content file to enter the "user" password. Under normal circumstances a distributor of a password protected PDF file, must disclose the user or "open" password to the user so they can open and view the file. By doing so they expose the "Owner" password to attack by ElComsoft's password cracker. Elcomsoft's program will "not" work if the user and owner passwords are unknown.
>
> [0004] Thus, a need exists to distribute a password protected content file without revealing a password to the recipient or user. It is to such a system and method that the present invention is directed. With respect to PDF files, an attribute of the present invention is that the recipient or user cannot learn either the user or the owner password. Thus, the recipient or user cannot use Elcomsoft's program to attack the owner password.

The inventive concepts of claims 1 and 20 permit an owner to distribute a password-protected content file to a user without making the password protecting the content file known to the user, i.e., without revealing the password protecting the content file to the user, thereby preventing the user from "attack[ing] the owner password."

Independent claim 1 is directed to a method for distributing a password protected content file without revealing to a recipient a password that protects the password protected content file. The invention recited in independent claim 1 requires the inventive steps of:

> distributing from one or more owner's computer to a recipient's computer an unlocking program having a password embedded within the unlocking program, the password corresponding to the password that protects the password protected content file; and

distributing the password protected content file from the one or more owner's computer to the recipient's computer wherein the unlocking program includes logic that when executed by the recipient's computer causes the unlocking program to run separately from and monitor at least one application program and to automatically supply the password embedded within the unlocking program to the at least one application program upon the at least one application program loading the password protected content file wherein the password embedded within the unlocking program is not revealed to a recipient using the recipient's computer.

Similar limitations can be found in Applicant's independent claim 20, as amended, i.e., "wherein the password locking the password protected content file is not revealed to a recipient viewing the password protected content file."

Martinez, on the other hand, is not directed to a system to distribute a password protected content file at all and, instead teaches a system whereby a user must know the relevant password. Martinez teaches a "password wallet" which is intended to serve as "a system and method which provides a centralized, secure password storage facility, with quick and easy user access of those passwords without circumventing security measures such as log-on procedures." (see column 2, lines 61-65) (emphasis added). Generally, Martinez teaches a system where a user who has multiple logon credentials, i.e., login ids and passwords, for a variety of web sites and/or applications registers or enters each of the logon credentials into the password wallet. The password

wallet uses one master login id and password which is presumed to be easier to remember by the user. Thus, when the user attempts to access a particular web site or open an application, the password wallet intercepts the login screen, asks the user for the password wallet master logon credentials, and, if entered correctly by the user, the password wallet logs the user in to the desired web site or application.

However, it is important to note that the user using Martinez's system is required to know the login id and password for each website or application since that user must be the one who enters each login id and password into the password wallet for each and every website and/or application. Additionally, the user has ready access to such logon credentials once it has been loaded into the password wallet. In particular, Martinez recites:

> The wallet direct user interface (33) is also preferably provided, which also interfaces to the password wallet manager (32) via the generalized interface (34). This function allows the user to view all defined passwords, edit passwords, add or delete passwords, as desired. It may also allow the user to create and modify the master key value for the password wallet. (column 7, lines 4-10)(emphasis added)

Thus, Martinez clearly teaches a system wherein the user knows the relevant password.

The Office Action states that "Martinez teaches that there were several prior art wherein the user does not even have to manually enter a password to load a saved password." Therein, Martinez is referring to Microsoft's Internet Explorer "auto-complete" feature and Intuit's use of a quick-access PIN. As understood, each of these features requires that the user must first enter the logon credential to initially access the

site or application, i.e., the user is the one who saves the password. Then, the program simply remembers the logon credential for the user which permits the user to access the application or website without having to manually enter the login id and password again. Martinez's password wallet is intended to be an improvement on such systems. However, as in Martinez, each of the prior art features requires that the user know the password which means that the features are not the same as, and therefore do not disclose a method or system to distribute a password protected content file to a recipient "wherein the password embedded within the unlocking program is not revealed to a recipient using the recipient's computer."

The Office Action then offers the McDonald reference for the proposition that it teaches the limitation of "distributing to the recipient's computer an unlocking program having a password embedded within the unlocking program, the password corresponding to the password that protects the password protected unlocking content file." Applicant submits that McDonald's "Critter" does not supply the deficiencies noted above with respect to Martinez. Therefore, even if McDonald were combinable with Martinez, the combination does not disclose each of the inventive features recited in the pending claims.

McDonald's "Critter" illustrates an example of one of the security problems that the instant application solves. Critter encourages and enables end-users of application programs or password protected content files to contribute serial numbers and/or passwords to "Critter" so the serial numbers and/or passwords can be accessed easily by a nearly unlimited audience on the internet. This availability of serial numbers and

passwords greatly facilitates the unauthorized use of application programs or access to password protected files. Once serial numbers and/or passwords become known to end-users, some of those users will communicate the serial numbers/passwords to "Serials 2000" to enable other users to utilize the serial number to circumvent protected application programs or password protected content files without authorization and typically without paying for the application program or content file. The seriousness of the security issue is illustrated by the comment in this "Critter" internet publication that the previous Critter website was "shut down by the FBI".

However, Applicant notes that at least one user must know the passwords in order to post them to Serials 2000 and that once the passwords are posted, other users have ready access to, and therefore know the passwords in order to use them to circumvent the password protected application or content file. Therefore, McDonald suffers from the same shortcomings described above with respect to the Martinez reference. That is, in McDonald's system, the password must be revealed to the users.

In view of the above, Applicant submits that the combination of Martinez and McDonald does not teach or suggest the inventive features recited in the pending claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 20-21, 23 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Martinez in view of McDonald and passage of said claims to allowance.

Rejection of Claim 22 – 35 U.S.C. § 103

The Office Action then rejects dependent claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Martinez in view of Grant McDonald and further in view of Schreiber et al. (U.S. Pat. No. 6,298,446). The Office Action offers Schreiber for the proposition that it teaches "a means for preventing a screen capture representing at least a portion of the content stored in the password [protected] content file," as recited in claim 22. However, the Office Action does not suggest that the Schreiber reference teaches the limitations noted missing from Martinez and McDonald with respect to independent claim 20, from which claim 22 depends. Applicant submits that Schreiber does not provide such deficiencies noted missing from Martinez and McDonald. Therefore, even if Schreiber taught everything that the Office Action suggests, the combination of Schreiber with Martinez and McDonald does not teach all the limitations recited in independent claim 20, and therefore claim 22 which depends therefrom.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 22 under 35 U.S.C. § 103(a) and passage of said claim to allowance.

Rejection of Claims 24-29 – 35 U.S.C. § 103

The Office Action then rejects dependent claims 24-29 under 35 U.S.C. § 103(a) as being unpatentable over Martinez in view of Grant McDonald and further in view of Winneg et al. (U.S. Pat. No. 7,069,586). Applicant notes that dependent claim 28 is

cancelled from consideration in the instant application. Therefore, the rejection of claim 28 is rendered moot.

The Office Action offers the Winneg reference for the proposition that it teaches "monitoring the running of at least one system administration program [capable of terminating the unlocking program]," as recited in dependent claim 24. However, the Office Action does not suggest that the Winneg reference teaches the limitations noted missing from Martinez and McDonald with respect to independent claim 20, from which claims 24-29 depend. Applicant submits that Winneg does not provide such deficiencies noted missing from Martinez and McDonald. Therefore, even if Winneg taught everything that the Office Action suggests, the combination of Winneg with Martinez and McDonald does not teach all the limitations recited in independent claim 20, and therefore claims 24-27 and 29 which depends therefrom.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 24-27 and 29 under 35 U.S.C. § 103(a) and passage of said claims to allowance.

Allowable Subject Matter

The Office Action states that claims 4 and 32 would be allowable if rewritten to overcome any objections or rejections set forth in the instant Action and to include all of the limitations of the base claim and any intervening claims. Applicant notes that claims 31-32 are herein cancelled from consideration in the instant application.

Applicant wishes to thank Examiner Pich for indicating the allowability of said claims. However, as discussed above, Applicants believes that the currently pending claims are in condition for allowance. Therefore, Applicant respectfully requests a Notice of Allowance to be issued in the instant case.

CONCLUSION

This is intended to be a complete response to the Office Action mailed November 19, 2009. For the reasons set forth above and the amendments submitted herewith, Applicant believes that the pending claims are in condition for allowance and therefore respectfully requests reconsideration and withdrawal of each objection and/or rejection of the pending claims and passage of said claims to allowance.

Should the Examiner have any questions regarding the instant application, or the remarks contained herein, Applicant's attorney would welcome the opportunity to discuss such matters with the Examiner.

Respectfully submitted,

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